

## **REMARKS**

Applicants thank the Examiner for finding claims 28, 32-34, 37 and 38 to be allowable. Applicants respectfully request reconsideration of the above referenced patent application in view of the remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. No claims have been amended. No claims have been canceled. No claims have been added. Thus, claims 22, 26-28, 32-34, 37 and 38 are pending.

### **35 U.S.C. §101 Rejections**

The Office Action rejects claims 22, 26 and 27 under 35 U.S.C. §101 as being directed toward non-statutory matter. Each of the above rejected claims includes the limitations of rejected claim 22, which recites in a salient portion:

“...if the third determination is true and if at least one of the first determination and the second determination is also true, then  
spinning down the HD, and  
servicing HD data transactions with the NVC while the HD is spun down.”

In rejecting the above claims under 35 U.S.C. §101, the Office Action admits that spinning down a HD is at least one useful, concrete and tangible result of which the method in rejected claim 22 is capable. However, the Office Action alleges that since such spinning down the HD is conditional, rejected claim 22 does not **ensure** a “useful, concrete and tangible result.” Applicants traverse the above rejection for at least the following reasons.

Contrary to the assertions of the Office Action, Applicants respectfully submit that claim 22 **does ensure** at least one useful, tangible and concrete result. More particularly, the claimed invention provides the useful, tangible and concrete result of spinning down the HD in a particular circumstance **within the claim’s scope**, i.e. if the third determination is true and if at least one of the first determination and the second determination is also true. A particular useful, concrete and tangible result of a claimed invention, provided by performing of a particular action in a particular circumstance, is **no less** a useful, concrete and tangible result **merely** because, in an alternative circumstance which is **not** in the scope of the claim, it may (or may not) be

desirable (1) to perform a particular different action, (2) to perform no particular action, or even (3) to specifically perform **no action** at all. Claim 22 makes no claim to any particular useful, concrete and tangible result for circumstances outside of its scope. However, the mere fact that claim 22 allows for any of a variety of other, distinctly separate results to occur in circumstances **outside** of its scope does not mean that those circumstances **within** its scope do not provide for a useful, tangible and concrete result.

The Office Action **fails** to provide any statutory or judicial support for an interpretation of 35 U.S.C. §101 which requires a claimed invention to provide useful, concrete and tangible results for circumstances **outside** of its scope. As noted above, the Office Action acknowledges that "spinning down the HD" is at least one useful, concrete and tangible result of which the method in rejected claim 22 is **capable**. Applicants respectfully submit that this **capability** to achieve a useful, concrete and tangible result is **sufficient** for the requirements of utility under 35 U.S.C. §101, as indicated by the case law cited below (emphasis added).

Section 101 of the Patent Act of 1952, 35 U.S.C. § 101, provides that "whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof," may obtain a patent on the invention or discovery. **The threshold of utility is not high:** An invention is "useful" under section 101 if it is **capable of providing some identifiable benefit**. See *Brenner v. Manson*, 383 U.S. 519, 534, 16 L. Ed. 2d 69, 86 S. Ct. 1033 (1966); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992) ("To violate § 101 the claimed device must be **totally incapable of achieving a useful result**"); *Fuller v. Berger*, 120 F. 274, 275 (7th Cir. 1903) (test for utility is whether invention "is **incapable** of serving **any** beneficial end").

- *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366

The utility requirement of § 101 mandates that the invention be **operable to achieve useful results**. See *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 U.S.P.Q.2D (BNA) 1401, 1412 (Fed. Cir. 1992).

- *In re Swartz*, 232 F.3d 862, 863

To violate § 101 the claimed device must be **totally incapable** of achieving a useful result, see *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing G.m.b.H.*, 945 F.2d 1546, 1552-53, 20 USPQ2d 1332, 1338 (Fed. Cir. 1991); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1268, 229 USPQ 805, 811 (Fed. Cir. 1986), cert. denied, 479 U.S. 1030, 93 L. Ed. 2d 829, 107 S. Ct. 875 (1987); *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 762, 221 USPQ 473, 480 (Fed. Cir. 1984), a determination of fact, *Raytheon*, 724 F.2d at 956, 220 USPQ at 596.

*- Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1571 (Fed. Cir. 1992)*

With regard to the defense of **no utility** (available equally at law and in equity), we hold that the true inquiry is, Was the government improvident in making the grant? Does the opposing evidence, the grant itself being prima facie proof of utility, go to the extent of establishing not merely that the device has been used for pernicious purposes, but that it is **incapable** of serving **any** beneficial end?

*- Fuller v. Berger, 120 F. 274, 275 (7th Cir. 1903)*

Based on the above-cited case law, Applicants submit that the method of rejected claims 22, 26 and 27 meet the requirements of 35 U.S.C. §101 at least insofar as they are **capable of providing some identifiable benefit**. In other words, each of claims 22, 26 and 27 is **operable to achieve** at least one useful result, and is **not totally incapable** of achieving such result. Furthermore, Applicants submit that any contrary interpretation of 35 U.S.C. §101 must be **clearly supported** by evidence of Congressional intent in the legislative history. As indicated in M.P.E.P. §2106(IV)(A) (emphasis added):

The plain and unambiguous meaning of section 101 is that **any new and useful** process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's **intent not to place any restrictions** on the subject matter for which a patent may be obtained **beyond those specifically recited** in section 101 and the other parts of Title 35.... Thus, it is **improper to read into section 101 limitations** as to the subject matter that may be patented **where the legislative history does not indicate that Congress clearly intended such limitations**.

*- In re Alappat, 33 F.3d 1526, 1542 (Fed. Cir. 1994) (en banc)*

For at least the foregoing reasons, Applicants submit that each of claims 22, 26 and 27 provide at least one useful, concrete and tangible result, and meets the requirements of 35 U.S.C. §101. Accordingly, Applicants request that the above 35 U.S.C. §101 rejection of claims 22, 26 and 27 be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 22, 26-28, 32-34, 37 and 38 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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Date: 9/13/2007

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